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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,182	08/28/2003	Jeffrey J. Terlizzi	1400-35	6462
7590	07/06/2006			EXAMINER HESS, DANIEL A
George Likourezos, Esq. Carter, DeLuca, Farrell & Schmidt, LLP Suite 225 445 Broad Hollow Road Melville, NY 11747			ART UNIT 2876	PAPER NUMBER
DATE MAILED: 07/06/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/650,182	TERLIZZI, JEFFREY J.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Daniel A. Hess	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 22 May 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-25 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>5/2006</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

### ***Oath/Declaration***

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

Mr. Jeffrey Terlizzi did not sign the new Oath.

While Mr. Terlizzi did sign a previous Oath, that previous Oath is improper because it did not name all of the inventors.

Therefore, a new oath is required, in which all of the inventors are named, which is signed by all of the inventors.

### ***Affidavit Under 37 CFR 1.131***

The Applicant is not granted priority to either Dec. 3, 1999 or Dec. 8, 1999.

The Affidavit filed under 37 CFR 1.131 does not meet the requirements of 37 CFR 1.131. Notwithstanding the fact that the it is questionable whether the evidence provided substantially conveys the Instant Invention, the requirements 37 CFR 1.131 (b) are not addressed at all. In particular, there is (a) no showing of reduction to practice (the block diagram is evidence of

**an idea or concept but it does not constitute reduction to practice and (b) there is no evidence of continuous due diligence from Dec. 1999 all the way up until filing. In fact there is instead a very large gap of time.**

**The following is a recitation of 37 CFR 1.131 (b):**

*(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.*

**The following is an excerpt from MPEP 715.07 which details the ways to show prior invention.**

#### **THREE WAYS TO SHOW PRIOR INVENTION**

*The affidavit or declaration must state FACTS and produce such documentary evidence and exhibits in support thereof as are available to show conception and completion of invention in this country or in a NAFTA or WTO member country (MPEP § 715.07(c)), at least the conception being at a date prior to the effective date of the reference. Where there has not been reduction to practice prior to the date of the*

*reference, the applicant or patent owner must also show diligence in the completion of his or her invention from a time just prior to the date of the reference continuously up to the date of an actual reduction to practice or up to the date of filing his or her application (filing constitutes a constructive reduction to practice, 37 CFR 1.131).*

*As discussed above, 37 CFR 1.131(b) provides three ways in which an applicant can establish prior invention of the claimed subject matter. The showing of facts must be sufficient to show:*

*(A) > (actual)< reduction to practice of the invention prior to the effective date of the reference; or*

*(B) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to a subsequent (actual) reduction to practice; or*

*(C) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice).*

A conception of an invention, though evidenced by disclosure, drawings, and even a model, is not a complete invention under the patent laws, and confers no rights on an inventor, and has no effect on a subsequently granted patent to another, UNLESS THE INVENTOR FOLLOWS IT WITH REASONABLE DILIGENCE BY SOME OTHER ACT, such as an actual reduction to practice or filing an application for a patent.

Automatic Weighing Mach. Co. v. Pneumatic Scale Corp., 166 F.2d 288, 1909 C.D. 498, 139 O.G. 991 (1st Cir. 1909).

*Conception is the mental part of the inventive act, but it must be capable of proof, as by drawings, complete disclosure to another person, etc. In Mergenthaler v. Scudder, 1897*

*C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897), it was established that conception is more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also.*

*In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose.*

From this, it should be clear that there isn't evidence to support any of A, B or C above.

Therefore, the Kelly et al. reference (US 6,705,527) is still considered applicable.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-5, 7, 8, 10-13, 15, 17-20, 22, are rejected under 35 U.S.C. 102(e) as being anticipated by Kelly et al. (US 6,705,527).

Kelly discloses a data acquisition device (a data reading device 10, such as a bar code scanner ) for acquiring bar code data (see figure 1.), at least one host device (30a-30n) for receiving and processing the acquired data; and an interface controller for interfacing the data acquisition

device to the at least one host device (see figure 2), said interface controller comprising: a microcomputer 60 for receiving data from the data acquisition device, including the acquired data, and outputting a host device type signal (see figure 2) and interface circuitry 70, 80 in operative communication with the microcomputer 60 for receiving the host device type signal (via based on the different pin signal received) and the data received by the microcomputer 60, selecting at least one interface from a plurality of interfaces in accordance with the host device type signal (see col. 8, lines 10+), and transmitting the received data including the acquired data (decoded bar code data) to at least one host device. The scanner functional block diagram shows (see figure 2) the plurality of drivers 70, 80 for driving output signal to voltage levels acceptable by the at least one host device, and further teaches a multiplexer (shown as an I/O multiplexer circuitry in figure 2) as a plurality of switches for coupling host specific outputs from the microcomputer to an output connector of the interface controller by selecting particular interface driver circuit to be used when sending data signal to the output connector 90 (see col. 5, lines 1+, col. 7, lines 39+\*, col. 9, lines 11+, and figure 2).

**Regarding the newly added limitations (a single circuit board for multiple interfaces, where one of the interfaces is USB) see figures 5a and 5b.**

The following is an excerpt from column 3; the UIDA is equivalent to a circuit board and USB is one among a number of modes supported.

The present invention relates in one aspect to a "universal" interface driver preferably taking the form of what is referred to herein as a Universal Interface Driver ASIC (UIDA) capable of supporting multiple electronic data

interface types using shared communications lines, for use in a data reader or other acquisition device. In a preferred embodiment, interface circuitry ordinarily housed on the data reader's interface driver circuit board is instead integrated onto the UIDA. Combining the circuitry supporting multiple host interfaces into an ASIC (Application Specific Integrated Circuit) generally allows for more compact circuit assemblies within the data reader and may increase the number of host device interfaces that are supported by a given data acquisition device.

In a preferred embodiment, the UIDA supports any combination of at least the following interfaces and functions: 1) RS-232C, 2) IBM46XX, 3) USB

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 2, 6, 9, 14, 16, 21, 24, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly et al. (US 6,705,527).

Re claim 2, 9, 16, 21: While Kelly et al. in general shows hard-wiring rather than modules stored in memory, it is understood in the hard that both approaches are equivalent.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the old and well-known program procedures for converting the data type rather than hard-wiring because programming can be easily updated to add additional formats by loading new software. Hardwiring does not have this benefit.

Re claim 6: In Kelly et al. it is presumed that decoding takes place at the scanner. If the scanner is connected to the interface controller, then they can be seen as a continuous system, and it can be said that the scanner performs decoding, at least to a certain extent.

Re claim 14: In the present case, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the scanner and universal connector integral, because in this way one can produce a scanner that is universally connectable.

There is no unexpected result from making integral.

Re claim 24: It is common and typical in the art of computing systems to check ports to confirm that needed peripherals are connected. The motive is simply to detect the common and easily-solved problem of incomplete connections.

Re claim 25: It is clear that one should connect a host-specific output to a particular host device because that is just what it was designed for in Kelly et al.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly et al. in view of the Symbol Product Reference Guide (of record in IDS of 5/22/06).

Selecting an interface type for a barcode scanner by scanning a barcode is shown throughout the LS 2501 Programmer's Guide.

In view of Symbol's teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to input the interface type by allowing the user to scan a barcode because the system already includes a banner and this can keep the scanner design simple by reusing this same input.

#### *Response to Arguments*

The affidavit filed on 5/22/06 under 37 CFR 1.131 has been considered but is ineffective to overcome the Kelly et al. reference.

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Kelly et al. reference to either a constructive reduction to practice or an actual reduction to practice. **A substantial gap of several years is present, which is unaccounted for.**

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Kelly et al. reference. The schematics that were submitted as evidence do not constitute an effective reduction to practice.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

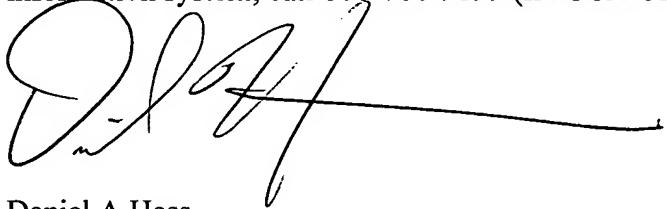
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel A. Hess whose telephone number is (571) 272-2392. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Daniel A Hess  
Examiner  
Art Unit 2876  
6/23/06



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PRIMARY EXAMINER